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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,326	03/24/2004	Shinya Nagano	3273-0188PUS1	4009
2292	7590	05/26/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			HAMPTON HIGHTOWER, PATRICIA	
PO BOX 747			ART UNIT	PAPER NUMBER
FALLS CHURCH, VA 22040-0747			1711	

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/807,326	NAGANO ET AL.	
	Examiner	Art Unit	
	Patricia Hightower	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 9 is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 24 March 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/24/04 & 9/8/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

Priority

The priority documents filed March 24, 2004 are acknowledged and have been made of record.

Information Disclosure Statement

The information disclosure statements filed March 24, 2004 and September 8, 2004 have been considered and have been made of record.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Feinstein et al (USP 4,142,036).

Feinstein et al (USP 4,142,036) discloses polyphenylcarboxylic acid adamantane compounds and polymers prepared therefrom, wherein the polymers are useful for forming shaped objects such as film, fiber and molded parts that anticipates the claimed invention. See abstract; col. 1, lines 5-10,15-35, 50-60; col. 2, lines 9-12,18-40; col. 3, lines 7-43; col. 5, lines 51-68; col. 6, lines 1-53; col. 8, lines 38-68; the claims.

Feinstein teaches the substituted adamantane nucleus when incorporated into a polymer is known to be capable of providing unique physical properties, for example because of the geometric bulk of 1,3-dimethyladamantane in its polymers results in rigidity, high thermal stability, high glass transition temperatures, low crystallinity, high

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heat distortion temperatures and good hydrolytic stability. See col. 2, lines 18-27, 28-37. The patentee states a specific object is to provide new adamantane polyphenylcarboxylic acids, to provide novel adamantane polymers such as polyamides, polyesters and polyimides made from these acid compounds. See col. 2, lines 29-39.

The patentee teaches the adamantane polyphenyl carboxylic acid compounds containing two acyl moieties can be used to produce high molecular weight condensation polymers such as polyesters and polyamides by condensing with an organic compound providing two reactive groups derived from either a polyhydric alcohol, a polyamine, etc. See col. 5, lines 51-68; col. 6, lines 1-36.

Obviousness-type Double Patenting Rejection

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/807,426. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and the copending application S.N. 10/807,426 are claiming overlapping subject matter that is

viewed as not being patentably distinct. The instant application and the copending application are claiming a material for dielectric films that is a polymerizable composition comprising dissolving in an organic solvent an adamantane polycarboxylic acid derivative denoted by the formula (1), an aromatic polyamine denoted by the formula (2); a polymer that is the polymerized product of the polymerizable composition comprising the adamantane polycarboxylic acid denoted by formula (1) and the aromatic polyamine denoted by the formula (2) dissolved in an organic solvent and the dielectric film prepared from the polymer formed from an adamantane polycarboxylic acid denoted by the formula (1) and the aromatic polyamine denoted by the formula (2); wherein the dielectric film has a 5% weight loss temperature of 500°C or higher. The instant application is claiming a narrower variation, which is encompassed by the broader claimed invention of the copending application. In such an instance, it is viewed that one set of claims cannot be infringed without literally infringing the other set of claims. Therefore, an obviousness-type double patenting rejection is proper.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Inoue is cited to show the state of the art of admantane derivatives and process of preparing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Hightower whose telephone number is (571) 272-1073. The examiner can normally be reached on M-F from 9:30 A.M. - 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

P. Hampton Hightower
P. Hampton Hightower
Primary Examiner
Art Unit 1711